

## **REMARKS**

Entry of the foregoing amendments, along with reconsideration of this application, are respectfully requested in view of the following remarks.

### **Claims 1-10, 17-23, 27-29, and 32-47 are Allowable Over the Cited Art**

Claims 1-6, 8-10, 17, 27, and 34-36 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Publication No. 2001/0029353 to Peterson (Peterson). Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Peterson. Claim 18 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Peterson in view of U.S. Patent No. 4,498,902 to Ash et al. (Ash). Claims 20 and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Peterson in view of U.S. Patent No. 6,875,219 to Arramon et al. (Arramon). Claims 19, 22, 23 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Peterson in view of PCT Publication No. WO 98/36785 to Stouder (Stouder). Claims 29, 32, 33 and 37-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Peterson in view of U.S. Patent No. 5,695,475 to Best Jr. et al. (Best). Claims 42 and 43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Peterson in view of Best and further in view of Arramon. Claims 44 and 45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Peterson in view of Best and further in view of Stouder.

***Claim 1 and its dependent claims are patentable***

Independent claim 1, recites “[a] medical device . . . comprising: a first hollow member . . . ; a second hollow member . . . movably coupled to the first hollow member; and a wedge having a first configuration and a second configuration . . . the second hollow member being configured to move with respect to the first hollow member along a longitudinal axis defined by the first hollow member when the wedge is in the first configuration . . . .” The cited references (including Peterson, Ash, Stouder, Best and Arramon), alone or in proper combination, fail to disclose or suggest a medical device as recited in independent claim 1. Peterson fails to disclose or suggest a second hollow member movably coupled to the first hollow member and configured to move with respect to a first hollow member when a wedge is in a first configuration. Specifically, the inner flexible tube 115 of Peterson is secured to the main body 112 “at a location 123 near the end of the elongated section 112b, for example, using a heat weld, glue or other adhering substance.” (Peterson ¶ [0027]). Therefore, regardless of the position of the tube lock 132, the flexible tube 115 cannot move along a longitudinal axis defined by the main body 112 because it is secured to the main body 112 at location 123. Accordingly, the Applicant respectfully submits that independent claim 1, and its dependent claims (including new dependent claims 46 and 47), are allowable over the cited art.

Furthermore, the Applicant submits that the claims that depend from independent claim 1 are also allowable based on additional subject matter recited in such dependent claims. For example, claim 21 recites a medical device having “[a] marking being adapted to facilitate adjustment of a combined length of the first hollow member and the second hollow member.” Peterson fails to disclose or suggest such a limitation as recited by claim 21. Specifically, the combined length of the flexible tube 115 and the main body 112 of Peterson cannot be adjusted

because the flexible tube 115 is secured to the main body 112, as discussed above. Additionally, the Examiner failed to address the limitations of dependent claim 21 in the final office action. Accordingly, the Applicant respectfully submits that dependent claim 21 is patentable.

Moreover, claim 34 recites a medical device where “a combined length of [a] first hollow member and [a] second hollow member is longer than a length of the first hollow member.” Peterson fails to disclose or suggest such a limitation as recited by claim 34. Specifically, the flexible tube 115 of Peterson “fits within the channel of the elongated section 112b” of the main body 112 with “one end secured between a tube lock 132 and the upper portion 112a, and [the other] end secured at a location 123 near the end of the elongated section 112b.” (Peterson ¶ [0027]). Thus, a combined length of the main body 112 and the flexible tube 115 is not longer than the length of the main body 112. Additionally, the Examiner failed to address the limitations of dependent claim 34 in the final office action. Accordingly, the Applicant respectfully submits that dependent claim 34 is patentable.

***Claim 29 and its dependent claims are patentable***

Independent claim 29 recites “[a] medical device . . . comprising: a first hollow member . . . having a sidewall defining a groove, the groove having a longitudinal portion and a plurality of notches, the longitudinal portion of the groove defining an axis parallel to a longitudinal axis defined by the first hollow member; and a second hollow member in adjustable communication with the first hollow member for extending the unobstructed passageway provided by the first hollow member to a predetermined internal location, the second hollow member having a post configured to be disposed within the groove of the first hollow member, the post being

configured to move between the longitudinal portion of the groove and the plurality of notches of the groove, the post being configured to slide along the longitudinal portion of the groove when the second hollow member is adjusted with respect to the first hollow member.” The cited references (including Peterson, Ash, Stouder, Best and Arramon), alone or in proper combination, fail to disclose or suggest a medical device as recited in independent claim 29.

Specifically, the Examiner improperly combined Best with Peterson in rejecting independent claim 29. One of ordinary skill in the art would not look to a syringe apparatus when designing a laparoscopic tool. Specifically, one of ordinary skill in the art would not look to a device used to protect a user from a needle when designing a depth-adjustable cannula having an adjustable member and a main body configured to be placed within a body of a patient. Accordingly, the Applicant respectfully submits that independent claim 29, and its dependent claims, are allowable over the cited art.

## **CONCLUSION**

The Applicants believe that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that further personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided. Prompt and favorable consideration of this application is respectfully requested.

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